



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
--------------------	-------------	-----------------------	------------------

08/605,628 02/22/96 SIMONE

C EXAMINER 000/P0

B3M1/0429

DICKSTEIN SHAPIRO & MORIN
2101 L STREET NW
SUITE 400
WASHINGTON DC 20037

ART UNIT PAPER NUMBER

THOMAS, J

23

DATE MAILED:

04/29/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 1/22/97

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 (three) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-8 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 1-8 are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☒ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

Serial No: 08/605,628
Art Unit: 2411

-2-

DETAILED ACTION

Notice to Applicant

1. This communication is in response to Applicant's Appeal Brief filed 1/22/97, wherein Applicant appealed the Examiner's rejections of pending claims 1-8 under 35 U.S.C. 101 and 35 U.S.C. 103. Upon further re-consideration of the basis of the rejection made in previous Office Action with regard to 35 U.S.C. 101 and in light of the Examination Guidelines for Computer-Related Inventions, Examiner has decided to withdraw the "method of doing business" rejection, but has felt it necessary to maintain another rejection under 35 U.S.C. 101, albeit on different grounds, namely, that the invention is directed to an abstract idea and a mathematical algorithm without limitation to a practical application in the technological arts. As such, the finality of the rejection mailed 8/30/96 is hereby withdrawn due to the new grounds of rejection which follow.

However, Applicant is advised that the grounds of rejection for claims 1-8 based on the prior art patent to DeTore et al. Under 35 U.S.C. 103 remain unchanged. As such, while Applicant is welcome to amend the claims or to overcome the new grounds of

rejection given in this Office Action, any other type of amendments to the instant claims is discouraged, so as to expedite the closure of prosecution on the present application.

2. In a telephonic interview with Applicant's Representative, Steve Shahida, on April 25, 1997, the Examiner indicated that the finality of the rejection mailed 8/30/96 would be withdrawn due to the new grounds of rejection under 35 U.S.C. 101. In that telephonic interview, Applicant's Representative was also verbally advised of the statements given in the preceding paragraph.

Claim Objections

3. Claim 7 in the Appendix to the 1/22/97 Appeal Brief is objected to because of the following informalities:

(i) claim 7, line 11: the word "values" should apparently be --value-- ; and

(ii) claim 7, line 24: for the sake of avoiding confusion, the phrase "communicating means for" should apparently be deleted from claim 7, as claim 7 is a method claim and not an apparatus claim having the typical "means-plus-function" format.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, namely an abstract idea and a mathematical algorithm.

(A) Claim 1 represents an abstract idea that does not provide a practical application within the technological arts.

The claim is directed to "evaluating insurability of at least one individual" and nominally recites the use of "a computer system" to implement a series of underlying method steps to be performed on nominal computer hardware (e.g., entry means, memory). Claim 1 is written in the "means-plus-function" format. However, the claimed means (e.g., means for assigning weight values, means for assigning risk values, means for determining, etc.) do not appear to correspond to a specific machine or manufacture disclosed within the instant specification and thus

Serial No: 08/605,628
Art Unit: 2411

-5-

encompass any product of the class configured in any manner to perform the underlying process. In particular, the survey means is a database as recited at page 13, lines 1-7 of the specification. The means for assigning weight values, means for assigning risk values, means for determining a total value, evaluating means for comparing, and analyzing means are all software programs to be embodied within a general purpose computer (see page 12, lines 3-17 and page 13, line 12 to page 14, line 19 of the instant specification). The messaging means is a general purpose computer peripheral, such as a display device or printer, as recited at page 18, lines 6-12 of the instant specification, and appears to be used only when there are pre-defined suggestions for improving health and decreasing risk to be outputted to select individuals (i.e., note the language "for providing messages to at least such individual that contain said pre-defined suggestions" at lines 19-20 of claim 1, which implies that there are some individuals to which messages are NOT provided). Consequently, the claims, although within the technological arts, are not limited to a specific machine or manufacture.

However, although the claim is interpreted as being

Serial No: 08/605,628
Art Unit: 2411

-6-

implemented on a computer or automated machine in a manner such that it is within the technological arts, claim 1 still represents a non-statutory process in that no post-computer process activity is found. As the final element is a "communicating means for automatically communicating said level of insurance risk", no manipulation of data representing physical objects is found, as the data processed (i.e., the "level of insurance risk") within the instant claim is mathematical, and not physical, *per se*. As no physical transformation is performed, no practical application is found. Nor do any of the remaining dependent claims (i.e., claims 2-6) provide the necessary physical transformation to render the claims statutory.

The above deficiency may be cured by simply incorporating a final step that clearly represents a physical transformation of the data with post-computer process activity having a practical application provided there is clear support for such a recitation in the specification as originally filed.

Similar analysis holds for independent claim 7 and dependent claim 8, as well.

(B) Claims 1 and 7 also represent a solution to a purely

Serial No: 08/605,628

-7-

Art Unit: 2411

mathematical problem that does not provide a practical application within the technological arts. As noted above, the claims are not limited to a specific machine or manufacture. Consequently, the claims are analyzed based upon the underlying process recited therein. The claims are directed to "evaluating insurability of at least one individual" and recite steps that are purely mathematical in nature (e.g., assigning weight values, assigning risk values, determining a total value, comparing each of said total values, determining level of insurance risk such that both a cost and an insurability profile is determined). The insurability profile is considered to be mathematical in nature in that an embodiment of an insurability profile disclosed in the specification appears to be one of four quantitative ranges (see page 29, line 26 to page 30, line 15). Further, the steps of gathering information pertaining to an individuals' lifestyle, health, and medical tests; inputting gathered information; and receiving and storing gathered information, merely recite the necessary data gathering step required for computing the claimed mathematical functions. As the underlying final step claimed in claims 1 and 7, is merely "automatically communicating said level of insurance risk", it is not clear whether or not this step

Serial No: 08/605,628
Art Unit: 2411

-8-

involves any post-computer process activity (e.g., whether it is performed outside the computer and having a practical application that possesses a "real-world" value), and is thus considered to be insignificant post-solution activity. As a result, it appears that the claims effectively recite a mathematical algorithm divorced from a practical application in the technological arts, despite nominal references within the claims and in the specification to a computer or other well-known computer-related structures (i.e., central processing unit, memory, input device, output device, databases, etc.).

Please see Section IV.B.2(c) and (d) of the Examination Guidelines for Computer-Related Inventions, published on 2/28/96.

(C) Claims 2-6 and 8 incorporate the deficiencies of claims 1 and 7, respectively, through dependency, and are therefore rejected.

(D) Applicant is reminded that while an application can be amended to overcome the above rejections, no subject matter can be added that was not disclosed in the application as originally filed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeTore et al. (4,975,840), for the same reasons given in the previous Office Action mailed 8/30/96 (paper number 20; section 5, pages 6-8), and incorporated herein.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Thomas, whose telephone number is (703) 305-9588. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiners' supervisor, Gail Hayes, can be reached at (703) 305-9711. The fax phone number for this Group is (703) 305-5356.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Serial No: 08/605,628
Art Unit: 2411

-10-

J.T.
Joseph Thomas
April 25, 1997

Gail Hayes
GAIL O. HAYES
SUPERVISORY PATENT EXAMINER
GROUP 2400